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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,701

08/31/2007

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7261

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29602 7590 07/28/2010

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EXAMINER

MULCAHY, PETER D

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/565,701
Filing Date: August 31, 2007
Appellant(s): TESCHNER, ROMAN

Robert D. Touslee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/22/10 appealing from the Office action mailed 10/27/09.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1 and 3-19.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

DE 198 18 046

Schmid

10-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schmid DE 198 18 046.

Claim 1 is directed to a “glass fiber size comprising water, one film- former, which is polvvinl polyvinylpyrrolidone, an adhesion promoter and an organic acid for establishing a pH in the acidic range.”

Initially, it must be noted that the recitation “polvvinl polyvinylpyrrolidone” appears to be a typographical error. The claim should read –polyvinylpyrrolidone--. In the event that the subject matter is deemed allowable, then the appropriate amendment must be made.

The examples at page 6 of Schmid show the claimed glass fiber size comprising water, one film- former, which is polyvinylpyrrolidone, an adhesion promoter and an organic acid for establishing a pH in the acidic range. It is maintained that the claim language “one film- former, which is polyvinylpyrrolidone” does not exclude the addition of the polyamide. The claim is understood to read “comprising ... one film- former, which is polvvinl polyvinylpyrrolidone.” The fact that the claim comprises one film former that is specified, does not exclude additional film forming constituents. As such the claims are anticipated.

The claims are further rendered prima facie obvious under 35 USC 103. Specifically, in the event that the claims can be interpreted so as to be limited to a single polymeric component, as argued by applicant, then it is prima facie obvious to leave out a known ingredient and lose its known function. Here, the patent specifically addresses advantages obtained when using a combination of polymers. One of ordinary skill appreciates the advantages obtained when using the combination as taught in the art. Thus, one appreciates the function of each of the polymeric components and leaving

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one of them out and losing the attendant function is obvious. Applicant has failed to show or allege any unexpected results obtained when a single polymeric component is used.

(10) Response to Argument

Appellant argues that the claim limitation "one film-former, which is polyvinyl polyvinylpyrrolidone" excludes the polyamide component of Schmid and patentably distinguishes the claim from the cited art. It is alleged that this limitation renders the claims patentable because the cited art incorporates "two" film forming polymers. Appellant argues that the claims are directed to a size wherein "one" film former, specifically polyvinylpyrrolidone, is used. This cannot be found persuasive.

Again, the claim is understood to read "comprising ... one film-former, which is polyvinyl polyvinylpyrrolidone." The fact that the claim comprises one film former that is specified, does not exclude additional film forming constituents.

The claims are simply not drafted so as to exclude the polyamide of Schmid. The transitional language "comprising" is used and the claims are open to all other ingredients. The fact that "one" film former is recited as being the polyvinylpyrrolidone does not positively limit the claim to a single film forming constituent or a single polymeric constituent. To the contrary, additional film formers can be included, just one of them must be polyvinylpyrrolidone. Further, the claims are open to additional polymeric components, irrespective of the film forming properties possessed thereby. This is to say that if the polyamide were to perform a different function, such as a thickener, then this component is not excluded.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Peter D. Mulcahy/

Primary Examiner, Art Unit 1796

Conferees:

/David Wu/

Supervisory Patent Examiner, Art Unit 1796

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796